



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/576,339	04/18/2006	Jung Soo Ha	075820-0013	9401

20277 7590 06/08/2010
MCDERMOTT WILL & EMERY LLP
600 13TH STREET, N.W.
WASHINGTON, DC 20005-3096

EXAMINER

KANG, IRENE S

ART UNIT	PAPER NUMBER
----------	--------------

3695

MAIL DATE	DELIVERY MODE
-----------	---------------

06/08/2010

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/576,339	Applicant(s) HA ET AL.	
	Examiner IRENE KANG	Art Unit 3695	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 March 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) 7-9 and 12 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6, 10, 12, 13-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

The following is a Final Office Action in response to communications received March 8, 2010. Claims 1-6, 10, and 11 have been amended. New claims 13-17 have been added. Claims 1-6, 10, 11, and 13-17 remain pending and examined.

Response to Amendments and Arguments

As to the rejection of claims 1-6, 10 and 11 under 35 U.S.C. § 101, Applicant's amendments properly address the rejection which is therefore withdrawn.

As to the rejection of claims 1-6, 10 and 11 under 35 U.S.C. § 103, Applicant's arguments have been fully considered but are not persuasive. Applicant argues that the rationale for combining Yuan, Carlisle, and Yun is nothing more than a conclusory statement and is not sufficient to sustain a rejection under 35 U.S.C. § 103. Examiner respectfully disagrees. The rationale for combining the three references indicates that the references deal with the same field of endeavor and is not merely a conclusory statement.

Applicant also argues that Yuan does not teach the features of claims 1, 2, 4, and 5 and that the cited portions Yuan merely describe a buyer-seller relationship in the context of fraud protection and increase the certainty of ecommerce transactions. But Yuan goes beyond that and discloses the kind of purchase transaction that this kind of fraud protection would be useful in and the claimed features as detailed below.

Claim Rejections - 35 USC § 103

Art Unit: 3695

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1, 2, 4, 5, 10, and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over the publication by Frank S. Yuan (Publication No.: US 2002/0038277) in view of the patent by Carlisle et al. (Patent No.: 5,649,118), further in view of the International Publication by Yun et al. (International Publication No.: WO 01/63520 A1) submitted in Applicant's IDS on August 3, 2009.

As to Claim 1, *Yuan* teaches a method that utilizes a processor to provide for providing a partial payment in ~~the~~ electronic commerce via the Internet (see at least Abstract, ¶[0002], ¶[0003], and ¶[0005]), the method comprising ~~the steps of~~:

receiving request information for purchase of goods from a user (see at least ¶[0004], ¶[0099], and ¶[0176] through ¶[0178]);

transmitting result information of the performed payment to the user (see at least Abstract, Figure 7, ¶[0072], ¶[0084], and ¶[0087]); and

transmitting request information for sale of ~~said~~ the goods based on ~~said~~ the result information of the performed payment (see at least Abstract, Figure 8, ¶[0072], ¶[0084], and ¶[0087]).

Although *Yuan* substantially teaches the disclosed invention, it does not specifically disclose ~~in response thereto~~, transmitting information on purchase particulars related to ~~said~~ the goods ~~including price of the goods~~ to the user in response to receipt of the request information for purchase of goods, wherein the information on purchase particulars comprises the price of goods; transmitting, using the processor, payment means forms information ~~including~~ relating to a plurality of payment ~~means~~ forms to the user; receiving selection information ~~on~~ relating to at least two payment ~~means~~ forms from the user, wherein the at least two payment ~~means~~ forms are selected by the user; and performing a partial payment, by which at least two portions of the price of the goods are paid by the at least two payment ~~means~~ forms. *Carlisle* does teach in response thereto, transmitting information on purchase particulars related to said goods including price of the goods to the user (see at least Col. 3, lines 38-54); transmitting payment means information including a plurality of payment means to the user (see at least Figure 13; Figure 14;

Art Unit: 3695

and Col. 21, line 37 through Col. 22, line 67); receiving selection information on at least two payment means from the user (see at least Figure 13; Figure 14; and Col. 21, line 37 through Col. 22, line 67); and performing a partial payment, by which at least two portions of the price of the goods are paid by the at least two payment means (see at least Figure 13; Figure 14; and Col. 21, line 37 through Col. 22, line 67). *Yun* teaches that the at least two payment means are selected by the user (see at least Page 11, 1st full ¶, and Page 12, 1st full ¶). It would have been obvious to one having ordinary skill in the art at the time of the invention to incorporate the features of *Carlisle* and *Yun* into the invention of *Yuan* since all the inventions look to increase convenience for users of related payment systems and methods in electronic commerce.

As to Claim 2, *Carlisle* teaches that ~~said~~ the plurality of payment ~~means~~ forms comprises at least one selected from a group consisting of cash, a credit card and a mobile phone (see at least Figure 13; Figure 14; and Col. 21, line 37 through Col. 22, line 67).

As to Claim 4, *Carlisle* teaches that ~~said~~ the plurality of payment ~~means~~ forms comprises at least two different credit cards (see at least Figure 13; Figure 14; and Col. 21, line 37 through Col. 22, line 67).

As to Claim 5, *Carlisle* teaches that the partial payment is performed ~~when~~ in response to a determination that the at least two portions of the price of the goods exceeds a predetermined value (see at least Figure 13; Figure 14; and Col. 21, line 37 through Col. 22, line 67).

Claim 10 is a non-transitory computer readable ~~record~~ medium ~~recording a~~ comprising an executable program which, when executed, perform the steps of the method according to Claim 1 and thereby rejected on the same grounds as Claim 1.

Claim 11 is a system for performing the method according to Claim 1 and thereby rejected on the same grounds as Claim 1.

Claim 13 is a system for performing the method according to Claim 2 and thereby rejected on the same grounds as Claim 2.

Claim 15 is a system for performing the method according to Claim 4 and thereby rejected on the same grounds as Claim 4.

Claim 16 is a system for performing the method according to Claim 5 and thereby rejected on the same grounds as Claim 5.

Claims 3 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over the publication by Frank S. Yuan (Publication No.: US 2002/0038277) in view of the patent by Carlisle et al. (Patent No.: 5,649,118) in view of Cole et al. (Publication No.: US 2002/0161707), further in view of the International Publication by Yun et al. (International Publication No.: WO 01/63520 A1) submitted in Applicant's IDS on August 3, 2009.

As to Claim 3, *Cole* teaches the method further comprising ~~the steps of, in case that a cash payment is included in the selection information,~~ transmitting account information to the user and receiving information on receipt of money related to the account, in response to the inclusion of a cash payment in the selection information, wherein ~~said~~ the request information for sale is transmitted after receiving the information on receipt of money (see at least Abstract, Figure 26, Figure 27, Figure 33, ¶[0015], ¶[0016], ¶[0068], ¶[0130]).

Although *Yuan*, *Carlisle*, and *Yun* substantially teach the disclosed invention, they do not specifically disclose the method further comprising the steps of, in case that a cash payment is

Art Unit: 3695

included in the selection information, transmitting account information to the user and receiving information on receipt of money related to the account wherein said request information for sale is transmitted after receiving the information on receipt of money. It would have been obvious to one having ordinary skill in the art at the time of the invention to incorporate the features of *Cole* into the inventions of *Yuan*, *Carlisle*, and *Yun* since all the inventions look to increase convenience for users of related payment systems and methods in electronic commerce.

As to Claim 6, *Cole* teaches that ~~said~~ the plurality of payment ~~means~~ forms comprise a plurality of credit cards and the number of the credit cards is restricted below a predetermined number (see at least Abstract, Figure 11, ¶[0013], and ¶[0099]).

Claim 14 is a system for performing the method according to Claim 3 and thereby rejected on the same grounds as Claim 3.

Claim 17 is a system for performing the method according to Claim 6 and thereby rejected on the same grounds as Claim 6.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after

Art Unit: 3695

the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to IRENE KANG whose telephone number is (571)270-3611. The examiner can normally be reached on 8am-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Charles Kyle can be reached on (571)272-6746. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/IRENE KANG/
Examiner, Art Unit 3695
6/9/2010

Application/Control Number: 10/576,339

Page 9

Art Unit: 3695

/Charles R. Kyle/

Supervisory Patent Examiner, Art Unit 3695